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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,998	08/26/2003	John Pether	131279.1034 (B.036AUS)	3085
60148 7590 06/23/2009 GARDERE / JHIF GARDERE WYNNE SEWELL, LLP 1601 ELM STREET SUITE 3000 DALLAS, TX 75201				
EXAMINER HYUN, PAUL SANG HWA				
ART UNIT 1797		PAPER NUMBER		
MAIL DATE 06/23/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/647,998

**Applicant(s)**

PETHER ET AL.

**Examiner**

PAUL S. HYUN

**Art Unit**

1797

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-17 and 22-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 13, 2009 has been entered.

Claims 1-33 are currently pending wherein claims 3 and 18-21 remain withdrawn pursuant to a restriction requirement. Applicant amended claim 1 and added new claims 27-33.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1, 2, 4, 5, 14-16, 22 and 24-33** are rejected under 35 U.S.C. 102(b) as being anticipated by Erdei (US 3,975,950).

Erdei discloses an apparatus for testing the strength of materials (see Fig. 6). The apparatus comprises a cubical container for receiving a specimen wherein the container comprises a base 12a, two opposing sides 53 and 54, and two opposing ends 58 and 59. The container further comprises a piston 25a for applying axial pressure.

Opposing sides 53 and 54 as well as opposing ends 58 and 59 are rigid and they are secured together for handling (see claim 12), but they are also outwardly displaceable upon actuation of piston 25a. The reference discloses that the shape of the container can be rectangular in cross-section (see line 40, col. 4).

It should be noted that the limitation "fixed" recited in the claims is being construed to mean "not readily moveable", not "physically attached". This interpretation is necessary because claim 2, for example, recites that at least one of said side walls is configured for outward movement. If the limitation "fixed" is construed to mean "physically attached", then the limitations recited in claim 2 would contradict the limitations recited in claim 1. A side wall that is physically attached to a base cannot be configured for outward movement.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erdei in view of Maddison (US 5,388,464).

Although Erdei discloses the use of hydraulics to bias the movement of the opposing sides and opposing ends of the apparatus, the reference does not disclose the use of a spring.

Maddison discloses a device for conducting stress tests. Similar to the apparatus disclosed by Erdei, the device comprises a piston to apply pressure to a sample. The reference discloses that the device can utilize either a hydraulic system or a spring to bias the piston (see Abstract). Because a spring is well known in the art to be a substitute for a hydraulic system, it would have been obvious to one of ordinary skill in the art to use a spring, including a leaf spring, to bias the walls of the apparatus disclosed by Erdei.

Claims **7, 8, 12, 13 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Erdei in view of Kellner (US 4,483,197).

Erdei does not disclose windows, a heating, a cooling means, or a lining configured to minimize friction.

With respect to the windows, Kellner discloses an apparatus for testing the strength of soil (see Fig. 1). The apparatus is configured to exert pressure on the soil sample that is placed inside the apparatus. The apparatus comprises a housing that is made from a transparent material to enable viewing of the sample (see line 65, col. 3). In light of the disclosure of Kellner, it would have been obvious to one of ordinary skill in the art to make at least a portion of the Erdei device out of a transparent material so that the sample can be viewed during testing.

With respect to the heating and the cooling means, the apparatus disclosed by Kellner further comprises a heater for heating the soil sample to simulate real-life soil temperatures (see lines 45-55, col. 5). In light of the disclosure of Kellner, it would have been obvious to one of ordinary skill in the art to provide the Erdei device with a heater so that it can also simulate real-life soil temperatures when soils are being tested. Likewise, it would have been obvious to one of ordinary skill in the art to provide a cooling means to simulate cold conditions.

With respect to claim 17, Kellner discloses the use of an anti-frictional coating 15 to minimize friction between the soil and the container. In light of the disclosure of Kellner, it would have been obvious to one of ordinary skill in the art to coat the inner surface of the slit disclosed by Erdei with an anti-frictional coating to minimize the damage to the apparatus caused by friction.

Claims **9-11 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Erdei in view of Wissa (US 3,635,078).

Erdei does not disclose a port that is in communication with the chamber of the testing apparatus.

Wissa discloses an apparatus for determining stress-strain properties of soil (see Figure). The apparatus comprises a chamber in which a soil sample is disposed, a piston for applying axial pressure, and a plurality of ports 11 and 15 that are in communication with the chamber. Ports 15 introduce water into the chamber, enabling one to determine the swell pressure of the soil sample (see Abstract). Port 11

communicates the chamber with a pressure transducer so that the swell pressure can be determined (see lines 36-40, col. 2). In light of the disclosure of Erdei, it would have been obvious to one of ordinary skill in the art to provide ports that are in communication with the chamber disclosed by Erdei so that the apparatus disclosed by Erdei can be used to determine the swell pressure of soil samples.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but they are moot in view of the new grounds of rejection. The amendment necessitated new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL S. HYUN whose telephone number is (571)272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul S Hyun/  
Examiner, Art Unit 1797

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797